UNITED STATES PATENT AND TRADEMARK OFFICE

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10/647,239	08/26/2003	Tadao Takami	241972US8	1755

22850 7590 02/08/2007	EXAMINER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.	PARK, JEONG S
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ALEXANDRIA, VA 22314	

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 August 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *8/3/2006*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   Foreign priority is not accepted because:

The inventors of applicants claimed as a foreign priority patent document (Japan

P2002-245598) do not match with the current application inventors.

Drawings

2.   The drawings are objected to because:

The labeled descriptive text "check results sending list" for 64 in Figure 10 does

not match with a description in the specification; and

The labeled descriptive text "new detection conditions sending unit" for 65 in

Figure 10 does not match with a description in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3.   Claims 1-3, 5, 8, 9, and 14 are objected to because of the following informalities:

In claim 1, line 11, "a letter string", it should be corrected as - -letter strings- - for

clear understanding;

In claim 2, line 7, "the plurality of letter strings", it should be corrected as - -the

plurality of the letter strings- - for clear understanding because it was mentioned in the

same claim;

In claim 3, line 3, "a plurality of mail", it should be corrected as - -the plurality of

mails- - for clear understanding because it was mentioned in claim 2;

In claim 5, line 8, "a user", it should be corrected as - -the user- - for clear

understanding because it was mentioned in claim 4;

In claim 5, line 9, "apllies", it should be corrected as - -applies- -;

In claim 8, line 3, "detected mail deletion means", it should be corrected as - -the

detection mail deletion means- - for clear understanding because it was mentioned

before;

In claim 8, line 6, "detected mail selection deletion means", it should be corrected

as - -the detection mail selection deletion means- - for clear understanding because it

was mentioned before;

In claim 9, line 3, "detected mail deletion means", it should be corrected as - -the detection mail deletion means- - for clear understanding because it was mentioned before;

In claim 9, line 6, "detected mail selection deletion means", it should be corrected as - -the detection mail selection deletion means- - for clear understanding because it was mentioned before; and

In claim 14, line 5, "a letter string", it should be corrected as - -the letter string- - for clear understanding because it was mentioned in the same claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 is drawn towards a mobile communication terminal comprising mail receiving means for receiving mail, detection conditions acquisition means for acquiring detection condition data, and detection means for performing detection processing. This can be just an abstract idea. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Claims 2-12, which are dependent on claim 1, do not add any tangible results to the claim and thus are rejected for the same.

Claim 13 is drawn towards a detection conditions distribution server comprising second detected mail processing control means for storing information. This can be just an abstract idea. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Claim 14 is drawn towards a detected mail notification receiving server comprising detected mail receiving means for detecting receiving information and communication charge return instruction means for sending instruction information. This can be just an abstract idea. In order for an abstract claim to be statutory, it must result in useful, concrete, and tangible results. The final result achieved by the claimed invention does not produce any tangible result.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Paul et al. (hereinafter Paul)(U.S. Patent No. 6,052,709).

Regarding claim 1, Paul discloses a mobile communication terminal, wherein a mobile communication terminal is interpreted as a user terminal (user terminal, see, e.g., col. 5, lines 46-48, reference character 130-132 in Figure 5) comprising:

A mail receiving means for receiving mail (an email storage database, reference character 206 in Figure 2, which receives and stores incoming email, see, e.g., col. 6, lines 26-29);

A detection conditions acquisition means for acquiring detection conditions data including a letter string (a spam probe, an email address which is a letter string, created by processor to identify sources of unsolicited email or spam, see, e.g., col. 4, lines 19-24) from a detection conditions distribution server (control center, see, e.g., reference character 101 in Figure 1, col. 5, lines 54-56) and storing the detection condition data in a detection conditions storage means (exclusion list manager, see, e.g., 202 in Figure 2, col. 5, lines 63-67)(alert signals received from the control center are automatically processed by the filtering application so that the source data extracted from the alert signals are automatically added to the stored exclusion list, see, e.g., col. 6, lines 17-25); and

A detection means for performing detection processing for extracting the mail received by the mail receiving means (email storage, 206 in Figure 2) when a condition, in which the mail includes a letter string conforming to the letter string included in the detection condition data stored in the detection conditions storage means (exclusion list manager, 202 in Figure 2), is satisfied (filtering application, 200 in Figure 2, see, e.g., col. 5, lines 54-62).

Regarding claim 2, Paul discloses the detection condition data includes a plurality of the letter strings (data categories, letter strings, are listed in the exclusion list, see, e.g., col. 6, lines 2-11, Figure 3).

Regarding claim 3, Paul discloses the list display means for displaying a list of

information for identifying a plurality of mail received by the mail receiving means,

respectively, in the list displaying, the list display means (user interface, 208 in Figure 2)

displays information for identifying the mail extracted (first display code indicating the

JUNK status of the message, see, e.g., col. 6, lines 46-49) by the detection means in a

mode different that of mail not extracted (second display code indicating the OK status

of the message, see, e.g., col. 6, lines 54-56) by the detection means (see, e.g., col. 6,

lines 26-58, Figure 2).

Regarding claim 4, Paul discloses the category information inputted by a user to

the detection conditions distribution server (exclusion list manager, 202 in Figure

2)(user exclusion list is created and modified manually by the user and exclusion list

manager creates and stores a user exclusion list, see, e.g., col. 5 line 63 to col. 6

line16).

Regarding claim 5, Paul discloses the detection condition selection control

means for storing selection information (exclusion list manager stores the user

exclusion list, see, e.g., col. 5, lines 63-67).

Regarding claims 6-8 and 13, Paul discloses as follows:

Detected mail (JUNK status of the message) deletion means for deleting the mail

received by the mail receiving means (the JUNK status of the message are

automatically discarded by the filter (email filter, 204 in Figure 2), see, e.g., col. 6, line

64 to col. 7, line 1);

Detected mail selection deletion means for providing a display for prompting a user to select whether or not to delete the extracted (display the message filtered out in a distinctive color in the user's in-box in order to decide whether or not to delete the message, see, e.g., col. 7, lines 1-8); and

First and second detected mail processing control means for storing information regarding whether the extracted mail is deleted with a display for prompting or without it based on an input by an administrator to the mobile communication terminal (displays the alternatives in user's inbox, see, e.g., col. 6, line 64 to col. 7, line 8).

Regarding claim 9, Paul discloses all the limitations as above.

Regarding claims 10 and 11, Paul discloses first detection conditions application control means for storing and acquiring detection condition application information, which regards whether is indispensable or being able to be selected by a user (email message marked with the first display code (JUNK mail) are further processed by the filter using user preference data entered by the user, see, e.g., col. 7, lines 16-36).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (hereinafter Paul)(U.S. Patent No. 6,052,709) in view of Satoh (Pub. No. US 2001/0038625 A1).

Regarding claim 12 and 14, Paul discloses that all detected mails are stored at a special folder in the user's in-box (see. e.g., col. 7, lines 1-8).

But Paul does not disclose for sending the detected mail information to the detected mail notification receiving server from a mobile communication terminal for the communication charge purpose.

The general concept of calculating, storing, and displaying communication charge through a mobile station is well known within the art as illustrated by Satoh (see, e.g., Page 2, Paragraph [0025], reference character 10 and 15 in Figure 1B).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Paul to include storing and displaying communication charge information for a billing purpose as taught by Satoh in order to improve customer's satisfaction for being charged only for the necessary delivery of email messages.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeong S. Park whose telephone number is 571-270-1597. The examiner can normally be reached on Monday through Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on 571-272--6681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSP
January 30, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER